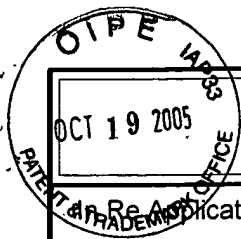


10-20-05

AF/IFW #/



TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
KDE-23702/03

Application Of: **Kenneth D. Eisenbraun**

Application No. 10/824,110	Filing Date April 14, 2004	Examiner Jonathon A. Szumny	Customer No. 25006	Group Art Unit 3632	Confirmation No. 6162
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Title: **MERCHANDISING HANGER**

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

Appeal Brief in Triplicate

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Dated: **October 19, 2005**

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Serial No. 10/824,110
Appeal Brief

Attorney Docket No. KDE-23702/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kenneth D. Eisenbraun

Serial No.: 10/824,110

Group Art Unit: 3632

Filing Date: April 14, 2004

Examiner: Jonathon A. Szumny

For: MERCHANDISING HANGER

APPELLANT'S BRIEF UNDER 37 CFR §1.192

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I. Real Party in Interest

The real party and interest in this case is Kenneth D. Eisenbraun, applicant and appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with eighteen claims. Claims 1-18 are pending, rejected and under appeal. Claims 1 and 10 are the independent claims.

IV. Status of Amendments Filed Subsequent to Final Rejection

An amendment under Rule 116 was filed on July 8, 2005 subsequent to the final rejection made in the Office Action dated April 27, 2005. However, the amendment filed July 8, 2005 was not entered.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to a merchandising hanger which includes a planar surface having a top and a base. The planar surface is adapted to receive printed indicia thereon and be suspended from a rod. A tab extends from the base of the planar surface, and the tab has a first tab portion, a third tab portion, a stud integral with one of the first tab portion or the third tab portion, and an aperture having a flange therein through the first tab portion or the third tab portion, whichever does not include the integral stud. Further, the first tab portion has a first tab portion thickness, the third tab portion has a third tab portion thickness, and intermediate between the first tab portion and the third tab portion is a second tab portion which has a second tab portion thickness. The second tab portion thickness is less than the first tab portion thickness. (Specification, page 2, lines 4-14; page 3, line 4 – page 4, line 2; and Figures 1-5).

Independent claim 10 is directed to a merchandising hanger which includes a planar surface having a top and a base. The planar surface is adapted to receive printed indicia thereon and be suspended from a rod. A tab extends from the base of the planar surface, and the tab has a first tab portion, a third tab portion, a stud integral with one of the first tab portion or the third tab portion, and an aperture having a flange therein through the first tab portion or the third tab portion, whichever does not include the integral stud. Further, the first tab portion has a first tab portion thickness, the third tab portion has a third tab portion thickness, and intermediate between the first tab portion and the third tab portion is a second tab portion which has a second tab portion thickness. The ratio of the first tab portion thickness:second tab portion thickness:third tab portion thickness is 1.5-3.5:1:1.3-2.5. (Specification, page 2, lines 4-14; page 3, line 4 – page 4, line 6; and Figures 1-5).

Dependent claims 2 and 11 describe the hanger of claim 1 and 10 respectively wherein the stud has a body and a conical cap. (Page 3, lines 9-10; Figures 1-5).

Dependent claim 12 describes the hanger of claim 10 wherein the aperture has a flange therein. (Page 2, lines 9-10; page 3, lines 15-16; Figures 1-5).

Dependent claims 3 and 13 detail the hanger of claim 1 and 10 respectively wherein there is an opening adjacent to the base of the stud in the first tab portion or in the third tab portion integral therewith. (Page 4, lines 17-19; Figures 1, 3 and 4).

Dependent claims 4 and 14 describe the hanger of claim 1 and 10 respectively wherein the stud extends from the first tab portion and the aperture is through the third tab portion. (Page 3, lines 8-15; Figures 1-3).

Dependent claims 5 and 15 describe the hanger of claims 1 and 12, respectively; the flange is divided into a plurality of flange portions. (Page 3, lines 17-18 and Figures 3-4).

Dependent claims 6 and 16 are directed to the hanger of claims 1 and 12, respectively, wherein said planar surface and said tab are a single piece molded of a thermoplastic material. (Page 3, lines 4-6).

Dependent claims 7 and 17 describe the hanger of claims 2 and 11, respectively, wherein the conical cap is hemispherical. (Page 3, lines 10-11; Figures 2, 4 and 5).

Dependent claim 8 details the hanger of claim 1 wherein the ratio of the first tab portion thickness:second tab portion thickness:third tab portion thickness is 1.5-3.5:1:1.3-2.5. (Page 4, lines 5-6; Figures 1, 2 and 5)

Dependent claims 9 and 18 are directed to the hanger of claim 8 and 10 respectively wherein the first tab portion thickness is greater than the third tab portion thickness. (Claims 9 and 18, Figures 1, 2, and 5).

VI. Grounds of Objection/Rejection to Be Reviewed on Appeal

A. The rejection of claims 1, 2, 4-12 and 14-18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,401,304 to Dossett in view of U.S. Patent No. 5,367,809 to Ross.

B. The rejection of claims 3 and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,401,304 to Dossett in view of U.S. Patent No. 5,367,809 to Ross, and further in view of U.S. Patent No. 4,198,722 to Furutu.

VII. Argument

A. Claims 1, 2, 4-12 and 14-18

Claims 1, 2, 4-12 and 14-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,401,304 to Dossett in view of U.S. Patent No. 5,367,809 to Ross.

Firstly, Applicant rebuts the *prima facie* obviousness rejection of pending independent claim 1 on the basis that the claim recites limitations not afforded by the prior art reference combination. In particular, claim 1, line 5 recites “an aperture having a flange therein.”

The aperture having a flange extending therein described by claim 1 is well depicted in Figures 1 and 4 and the accompanying text found on page 3, line 12 – page 4, line 2. The flange intercedes into the aperture and is characterized by a thickness less than that of the tab portion (first or third) that defines the boundaries of the aperture. In this way, a stud can be press fit into an aperture that otherwise would not be deformable to receive the stud without compromising the theft deterrent considerable thicknesses of the first and third tab portions.

In contrast to pending claim 1, Dossett teaches a circular aperture 14 (see Figure 2) with no accommodation for the receipt of adhesive area 19. Since adhesive area 19 flares to a width greater than that of aperture 14, the adhesive area 19 necessarily must deform to be received

within hole 14. Ross teaches an aperture 20 having slits radiating into the aperture defining second end 13 such that the slits create a zone of deformation in the second end to allow the enlarged portion 16 to pass through the aperture 20. As such, Dossett fails to teach the limitation of a flange within the aperture and Ross does nothing to bolster Dossett in this regard. Combining the teachings of Dossett and Ross, one obtains a portion having an aperture with radiating slits there around to accommodate an enlarged portion of a stud found on another portion that upon coupling creates a loop.

Applicant submits that the combination of Dossett and Ross with regard to the aperture is different than that recited in the pending claim and is further submitted to fail to achieve the theft-deterrent aspect of the present invention. As detailed in the background of the invention at page 1, line 17 – page 2, line 1, theft and damage of a display is associated with the ease with which a stud is released from the securing aperture. The prior art reference aperture of Ross is typical of this prior art where the stud is readily pulled free from the aperture. Alternatively, the aperture of Dossett with no radiating slits to accommodate a stud would perform the theft deterrent even more poorly.

Thus, it is submitted that no *prima facie* case of obviousness is established since the references when combined do not teach or suggest all the claim limitations and therefore claim 1 and those claims that depend therefrom are nonobvious over the prior art reference combination of Dossett and Ross.

Secondly, with respect to both independent claims 1 and 10, Applicant rebuts the *prima facie* obviousness rejection on the basis that there is no motivation or suggestion in the prior art references to modify the reference or to combine reference teachings. Dossett is cited as claiming all of the claimed features with the exception of a:

tab to have a stud integral with one of the first tab portion or the third tab portion and an aperture having a flange therein through the first tab portion or the third tab portion not having the stud integral therewith, such that the first tab portion has a first tab portion thickness, the third tab portion has a third tab portion thickness, and the second tab portion has a second tab portion thickness where the second tab portion thickness is less than the first tab portion thickness.

(Paper No. 01062005, page 4, second paragraph).

Ross is cited to bolster the teaching of Dossett with regard to the relative thickness of the first, second, and third tab portions. As a result, the combination of references has been considered to render:

obvious to one of ordinary skill in the art at the time the invention was made to have modified the first, second and third tab portions of Dossett '304 to have a stud on one of first or third tab portions an aperture with a flange/flange portions therein on the other of the first or third tab portions such that the thickness of the second tab portion is less than that of the first tab portion as in Ross '809 so as to provide for a more secure and/or alternate connection between the first and third tab portions while allowing the second tab portion to bend more easily thus facilitating the connection between the first and third tab portions.

(Paper No. 01062005, page 5, first full paragraph).

With regard to independent claims 1 and 10, it is submitted that the primary reference of Dossett '304 teaches away from the prior art reference combination on the basis that the combination destroys a key attribute of Dossett. As such, it is submitted that independent claims 1 and 10, and those that depend therefrom (claims 2 and 4-9), are submitted to be nonobvious over the prior art reference combination of record.

Dossett '304 teaches a product stocking device to retain the relative position of a number of display packages such that they are readily aligned for mounting on a display hanger. The

inventive product stocking device is then removed (abstract, Figures 4 and 5). For the invention of Dossett '304 to be effective, Dossett '304 teaches that:

Because bag apertures 30 are substantially coaxially aligned, the plurality of bags may be slid directly onto display hanger 60 substantially simultaneously, as depicted in Fig. 4. Thus, the stocker has avoided having to individually mount each and every of the plurality of bags 20 onto display hanger 60.

(Column 4, lines 38-43). Were one of ordinary skill in the art to modify the first, second and third portions of Dossett '304 per Ross '809 as detailed in page 5 of the outstanding Office Action, Applicant is in agreement that the intermediate second tab portion would bend more easily. While this admittedly would facilitate connection of the first and third tab portions, doing so would destroy the automatic substantial coaxial alignment detailed in Dossett '304 that results from the intermediate second portion being of the same flexibility as the first and third portions. The prior art combination, by being more flexible in the intermediate second portion is submitted to destroy the value adding function of Dossett in saving the stocker from individually mounting each of the plurality of bags.

In light of Dossett '304 teaching away from a combination with Ross '809, it is respectfully submitted that pending claim 1 is nonobvious over the prior art of record. Reconsideration and withdrawal of the rejection of independent claim 1 and those that depend therefrom under 35 U.S.C. §103(a) over Dossett '304 in view of Ross '809 is solicited.

Thirdly, with respect to both independent claims 1 and 10, Applicant further rebuts the *prima facie* obviousness rejection on the basis that there is no motivation or suggestion in the prior art references to modify the reference or to combine reference teachings for another reason. As such, it is submitted that independent claims 1 and 10, and those that depend therefrom (claims 2 and 4-9), are nonobvious over the prior art reference combination of record.

Dossett '304 teaches a product stocking device to retain the relative position of a number of display packages such that they are readily aligned for mounting on a display hanger. The inventive product stocking device is then removed (abstract, Figures 4 and 5). Dossett '304 describes the problem to be solved by the Dossett '304 invention as improvement of "the efficiency of handling a multiplicity of display packages to be mounted onto display hangers." (Col. 1, lines 51-52). Dossett '304 further states that a "twist tie partially solves the problem of requiring a stocker to stock individual display bags one at a time." (Col. 1, lines 41-43). However, Dossett '304 also teaches that "[a] twist tie has the disadvantage of being difficult to manually disengage from the plurality of bags without the use of a suitable tool." (Col. 1, lines 43-45).

Were one of ordinary skill in the art to modify the first, second and third portions of Dossett '304 per Ross '809 to have a stud on one of first or third tab portions and an aperture with a flange/flange portions therein on the other of the first or third tab portions, Applicant submits that such a secure connection would destroy the advantage of the Dossett invention which provides a fastener which is easy to manually disengage without a tool. Thus, the prior art combination, by being more difficult to manually disengage, is submitted to destroy the improvement taught by Dossett.

In light of Dossett '304 teaching away from a combination with Ross '809, it is respectfully submitted that pending independent claims 1 and 10 are nonobvious over the prior art of record. Reconsideration and withdrawal of the rejection of independent claims 1 and 10, as well as those that depend therefrom, under 35 U.S.C. §103(a) over Dossett '304 in view of Ross '809 is solicited.

Finally, with respect to pending claims 8 and 9 that depend from claim 1, and claim 18 which depends from claim 10, Applicant submits that the prior art of record lacks a motivation to vary the thickness of the first tab portion relative to the third tab portion away from a 1:1 ratio. As a result, it is submitted that this represents an independent basis for potential allowability of claims 8, 9 and 18.

An inventive merchandise hanger has first, second and third portions having considerable thickness to inhibit theft. The theft deterrent is manifest in that the planar surface is sufficiently thick to prevent bending and therefore easy insertion into concealment on a thief such as in a pocket; the second portion, while thinner than the first portion and third portion, is also of considerable thickness so as to discourage scission to remove a product suspended from the resulting loop; and lastly, the first and third tab portions are of a thickness to discourage disengagement of the stud from the aperture. Having the first and third portions of different thickness means that any leverage inserted on the loop will necessarily deform the thinner portion more so than the thicker portion resulting in a stronger loop. Additionally, an excessively long stud according to the present invention becomes a point of weakness at the stud base where a strong connection between the aperture and the stud head is negated by pullout of the stud at its base.

In the Office Action mailed April 27, 2005 the Examiner states that:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the first tab portion and the third tab portion to be any number of various dimensions, including the first tab portion being thicker than the third tab portion, because doing so is considered a design choice and hence not considered patentable **since the applicant has not specifically recited in the originally filed specification why such a dimension is critical to the invention or produces any unexpected result.**

(Citing *In re Kuhle*, 526 F.2d 553, 188, USPQ 7 (CCPA 1975), emphasis in original document, Paper No. 04252005, page 6).

The Examiner maintains this position in the Advisory Action mailed July 14, 2005, stating that "... absent reasoning in the specification as to why such dimensions are critical to the functionality of the invention, doing so is considered a design choice and hence not patentable." (Paper No. 07062005, page 3).

Applicant submits that it is improper to require evidence and arguments responsive to an obviousness rejection to be found within the specification in order to be considered.

The Manual of Patent Examining Procedure, section 716.02(f), cites established case law and is quite clear on this point:

The totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. Therefore, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded. *In re Chu*, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995) (Although the purported advantage of placement of a selective catalytic reduction catalyst in the bag retainer of an apparatus for controlling emissions was not disclosed in the specification, evidence and arguments rebutting the conclusion that such placement was a matter of "design choice" should have been considered as part of the totality of the record. "We have found no cases supporting the position that a patent applicant's evidence or arguments traversing a § 103 rejection must be contained within the specification." There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances most significantly, the evidence and arguments proffered during the give-and-take of *ex parte* patent prosecution." 66 F.3d at 299, 36 USPQ2d at 1095.). (Emphasis added).

Further, the court reasons that

... the Board erred in apparently requiring Chu's evidence and arguments responsive to the obviousness rejection to be within his

specification in order to be considered. To require Chu to include evidence and arguments in the specification regarding whether placement of the SCR catalyst in the bag retainer was a matter of “design choice” would be to require patent applicants to divine the rejections the PTO will proffer when patent applications are filed. *In re Chu*, 36 USPQ2d 1089, 1094 (CAFC).

Applicant submits that the claim limitation of the first and third tab portions having differing thicknesses is nowhere found in the prior art references Dossett, Ross or the combination thereof. As this limitation is lacking in the prior art reference combination, Applicant submits that it is entitled to patentable weight.

With respect to claim 18, which depends from claim 10, Applicant submits that there is no motivation in the prior art to modify the thickness of the first tab portion such that it is greater than the third tab portion thickness. Applicant believes this is a separate basis for the potential allowability of claim 18.

In summary, Applicant submits that the pending claims recite limitations not found in the prior art reference combination and that such limitations are entitled to patentable weight on the basis of the above remarks. Reconsideration and withdrawal of the rejection as to claims 1, 2, 4-12 and 14-18 under 35 U.S.C. §103(a) over Dossett in view of Ross is solicited.

B. Claims 3 and 13

Claims 3 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,401,304 to Dossett in view of U.S. Patent No. 5,367,809 to Ross, and further in view of U.S. Patent No. 4,198,772 to Furutu.

On the basis of the limitations detailed above with regard to Dossett and Ross and the fact that Furutu fails to bolster these limitations, Applicant submits that claims 3 and 13 are likewise allowable on the basis of pendency from independent claims believed to be in allowable form.



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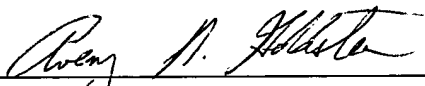
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As such, reconsideration and withdrawal of the rejection as to claims 3 and 13 under 35 U.S.C. §103(a) over Dossett in view of Ross and further in view of Furutu is solicited.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,


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Erica Triner

APPENDIX A

CLAIMS ON APPEAL

1. A merchandising hanger comprising:

a planar surface having a top and a base, the planar surface adapted to receive printed indicia thereon and be suspended from a rod; and

a tab extending from the base of said surface, said tab having a stud integral with one of a first tab portion or a third tab portion and an aperture having a flange therein through the first tab portion or the third tab portion not having the stud integral therewith, the first tab portion having a first tab portion thickness, the third tab portion having a third tab portion thickness, and intermediate between the first tab portion and the third tab portion a second tab portion having a second tab portion thickness where the second tab portion thickness is less than the first tab portion thickness.
2. The hanger of claim 1 wherein the stud has a body and a conical cap.
3. The hanger of claim 1 wherein there is an opening adjacent to the base of the stud in the first tab portion or in the third tab portion integral therewith.
4. The merchandising hanger of claim 1 wherein the stud extends from the first tab portion and the aperture is through the third tab portion.
5. The hanger of claim 1 wherein the flange is divided into a plurality of flange portions.

6. The hanger of claim 1 wherein said planar surface and said tab are a single piece molded of a thermoplastic material.

7. The hanger of claim 2 wherein the conical cap is hemispherical.

8. The hanger of claim 1 wherein the ratio of the first tab portion thickness:second tab portion thickness:third tab portion thickness is 1.5-3.5:1:1.3-2.5.

9. The hanger of claim 8 wherein the first tab portion thickness is greater than the third tab portion thickness.

10. A merchandising hanger comprising:

a planar surface having a top and a base, the planar surface adapted to receive printed indicia thereon and be suspended from a rod; and

a tab extending from the base of said surface, said tab having a stud integral with one of a first tab portion or a third tab portion and an aperture through the first tab portion or the third tab portion not having the stud integral therewith, the first tab portion having a first tab portion thickness, the third tab portion having a third tab portion thickness and intermediate between the first tab portion and the third tab portion a second tab portion having a second tab portion thickness wherein the ratio of the first tab portion thickness:second tab portion thickness:third tab portion thickness is 1.5-3.5:1:1.3-2.5.

11. The hanger of claim 10 wherein the stud has a body and a conical cap.
12. The hanger of claim 10 wherein the aperture has a flange therein.
13. The hanger of claim 10 wherein there is an opening adjacent to the base of the stud in the first tab portion or in the third tab portion integral therewith.
14. The merchandising hanger of claim 10 wherein the stud extends from the first tab portion and the aperture is through the third tab portion.
15. The hanger of claim 12 wherein the flange is divided into a plurality of flange portions.
16. The hanger of claim 12 wherein said planar surface and said tab are a single piece molded of a thermoplastic material.
17. The hanger of claim 11 wherein the conical cap is hemispherical.
18. The hanger of claim 10 wherein the first tab portion thickness is greater than the third tab portion thickness.

APPENDIX B

EVIDENCE

None.

APPENDIX C

RELATED PROCEEDINGS

None.